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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/382,421	08/24/1999	JEFFRY JOVAN PHILYAW	PHLY-24.740	5215
25883 7590 08/22/2007 HOWISON & ARNOTT, L.L.P P.O. BOX 741715 DALLAS, TX 75374-1715			EXAMINER LUU, LE HIEN	
			ART UNIT 2141	PAPER NUMBER
			MAIL DATE 08/22/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/382,421	<b>Applicant(s)</b> PHILYAW ET AL.	
	<b>Examiner</b> Le H. Luu	<b>Art Unit</b> 2141	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 May 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

1. Claims 1-9 are presented for examination.
2. In view of the Appeal Brief filed on 05/02/2007, PROSECUTION IS HEREBY REOPENED. New grounds of rejection is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is indefinite to claim "a visual indicia" comprises a machine readable code and a visual indicia. Applicant discussed in the Summary of Claimed Subject Matter in the Brief of Appeal filed on 05/02/2007 that **the machine readable code is a bar code** (reference number 1606 of Fig 16, reference number 2502 of Fig 25) and **the visual indicia is a LOGO** (reference number 2504 on Fig 25).

The limitations of claim 1 is indefinite because "a visual indicia" is combination of both a bar code and a logo, and "a visual indicia" is only a logo.

Applicant is request to amend claim 1 to clearly claim the limitation of the visual indicia.

5. The following is a quotation of 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claim 1 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The language of the claim "A visual indicia for facilitating computer based access of a network by a consumer" is directed to non-statutory subject matter based on nonfunctional descriptive subject matter per se.

Applicant discussed in the Summary of Claimed Subject Matter in the Brief of Appeal filed on 05/02/2007 that **the machine readable code is a bar code** (reference number 1606 of Fig 16, reference number 2502 of Fig 25) and **the visual indicia is a LOGO** (reference number 2504 on Fig 25).

When Examiner gives the limitation "A visual indicia for facilitating computer based access of a network by a consumer" its broadest reasonable interpretation in light of applicant's disclosure, "A visual indicia" is combination of a bar code and a logo which are not being considered as useful process, machine, manufacture, or composition of matter, or any new and useful improvement.

Examiner suggests applicant amends all claims to method or apparatus claims for further consideration.

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-9 are rejected under 35 U.S.C. § 103 (a) as being unpatentable over Perkowski patent no. 6,064,979, in view of Wilz, Sr. et al. (Wilz) patent no. 6,394,354.

9. As to claim 1, Perkowski teaches the invention substantially as claimed, including a visual indicia for facilitating computer based access of a network by consumer, comprising:

a machine readable code disposed on a surface of a product and having encoded therein information as to the product, which product is provided by the product manufacturer, and which machine readable code is physically associated with the

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product itself, which machine readable code has no routing information contained therein to allow a user to access any location on a network, and which machine readable code has a relationship to the product or service unrelated to routing information (col. 10 lines 14-33; UPC or UPN has relationship to a product or service but has no routing information);

the machine readable code being a part of a relational database that associates the machine readable code with a defined location on the network and the relational database associated with a routing system that facilitates connection to the remote location on the network (col. 6 line 26-56); and

a visual indicia having no apparent relationship to the machine readable code or to the defined location disposed on said surface in a predetermined proximate visual orientation to said machine readable code, such that the machine readable code and the visual indicia together form a defined composite visual appearance (Perkowski, col. 4 lines 5-23; col. 20 line 9-14; col. 21 line 52 - col. 22 line 19; trademark symbol or logo or company name is printed on service or product with bar code), indicative of a relationship between said machine readable code and the presence of a location on a network that will use the routing system for connection to the remote location and that such location on the network can be accessed by a computer having an appropriate input device (Perkowski, bar code reader or scanner) for reading said machine readable code, such that reading of said machine readable code by said input device will cause the routing system to connect the computer to the remote location (col. 10 line 14 – col. 11 line 16; col. 15 lines 9-43).

However, Perkowski does not explicitly teach the visual indicia associated with the routing system and indicates that scanning of the machine readable code will cause computer based access of the network.

Wilz teaches each URL encoded bar code symbol (machine readable code) is printed above each Web-site URL (visual indicia) which indicates that scanning of the URL encoded bar code symbol will cause computer based access the Web-site URL (col. 2 lines 49 - col. 3 line 12; col. 7 lines 20-40; col. 16 line 61 - col. 17 line 18).

It would have been obvious to one of ordinary skill in the Data Processing art at the time of the invention to combine the teachings of Perkowski and Wilz to provide a visual indicia on the same surface as the bar code or machine readable code to indicate that by scanning of the machine readable code will cause computer based access of the network because it would indicate to users the URL that contains additional information.

10. As to claim 2, Perkowski teaches said visual indicia is not machine readable (col. 4 lines 5-14; trademark or company name).

11. As to claims 3-6, Perkowski teaches said machine readable code represents a product, machine readable code is disposed on a product, machine readable code is closed association with said product, and machine readable code is a UPN (col. 4 lines 14-22; col. 12 line 65 – col. 13 line 9).

12. As to claim 7, Perkowski and Wilz teach the invention substantially as claimed as discussed above; however, Perkowski and Wilz do not explicitly teach said machine

readable code is an ISBN.

Official Notice is taken that ISBN is well known.

It would have been obvious to one of ordinary skill in the Data Processing art at the time of the invention to combine the well known teaching with Perkowski's system to use ISBN as one of machine readable code because it would allow user to get more information related to a publication.

13. As to claim 8, Perkowski teaches said machine readable code is an EAN (col. 6 lines 26-46; EPC reads on EAN which is European Article Numbering).

14. As to claim 9, Perkowski teaches said machine readable device is a scanner (col. 19 lines 38-40).

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Le H. Luu whose telephone number is 571-272-3884. The examiner can normally be reached on 7:00am - 4:30pm.

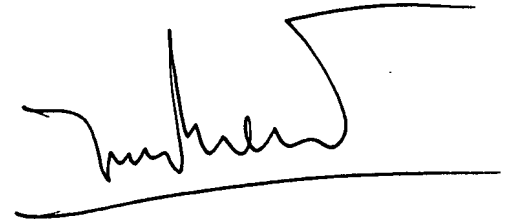
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia can be reached on 571-272-3880. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

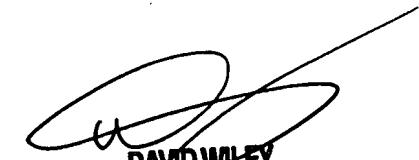


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you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Le Hien Luu', written over a horizontal line.

**LE HIEN LUU**  
**PRIMARY EXAMINER**

A handwritten signature in black ink, appearing to read 'David Wiley', written over a horizontal line.

**DAVID WILEY**  
**SUPERVISORY PATENT EXAMINER**  
**TECHNOLOGY CENTER 2100**